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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Hideo ITOH, et al. : GROUP ART UNIT: 1772

SERIAL NO.: 09/749,876 :

FILED: DECEMBER 29, 2000 : EXAMINER: CHEVALIER

FOR: PHOTOCATALYTIC COLORED MEMBER AND METHOD OF  
MANUFACTURING THE SAME

TECHNOLOGY CENTER 1700  
JUL 16 2002

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RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action dated May 7, 2002, Applicants elect, with traverse, Group I, Claims 1-45. In addition, Applicants elect, with traverse, (1b) circular, elliptical, or polygonal openings; (2c) uniform intervals; (3f) surface area of each layer that becomes larger when going from the surface toward the bottom layer; and (4h) titanium oxide of anatase structure. Claims 1-4, 6-7, 9, 12-13, 16-19, 21-22, and 27-28 read on the elected species.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-45, drawn to a photocatalytic colored member; and

Group II: Claims 46-49, drawn to a method of manufacturing a photocatalytic colored member.

In addition, with the election of Group I the Examiner is requiring the election of a single disclosed species for each of the following genera (1-4) from the species listed below:

1. Openings
  - a. parallel grooves
  - b. circular, elliptical or polygonal
2. Intervals
  - c. uniformity
  - d. nonuniformity
3. Surface area of each layer
  - e. equal
  - f. becomes larger when going from the surface toward the bottom layer
  - g. becomes smaller when going from the surface toward the bottom layer
4. Titanium oxide
  - h. anatase structure
  - i. amorphous structure.

Applicants elect, with traverse, Group I, Claims 1-45. In addition, Applicants elect, with traverse, (1b) circular, elliptical, or polygonal openings; (2c) uniform intervals; (3f) surface area of each layer that becomes larger when going from the surface toward the bottom layer; and (4h) titanium oxide of anatase structure. Claims 1-4, 6-7, 9, 12-13, 16-19, 21-22, and 27-28 read on the elected species.

The Office has characterized the inventions of Groups I and II as related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the product as claimed can be made by a different process "such as forming the openings by discontinuously adhering a layer." However, Applicants submit that the product of Group I is made by the process of Group II, and as such should not be separated. Moreover, there is no evidence of record to show that the claimed product can be made by this alleged process. If in fact the claimed product can be made by "forming the openings by discontinuously adhering a layer", Applicants respectfully submit that the Office has not shown how the alleged process is materially different from the claimed process. Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants’ election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Norman F. Oblon  
Attorney of Record  
Registration No.: 24,618

Vincent K. Shier, Ph.D.  
Registration No.: 50,552

PHONE NO.: (703) 413-3000  
FAX NO.: (703) 413-2220  
NFO:VKS  
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